

## ***REMARKS***

Applicant respectfully requests reconsideration of the present application in view of this response. Claims 1-33 are currently pending in connection with the present application, and claims 1, 2, 11, 22, 32, and 33 have been amended by way of this response. Claims 1, 11, and 22 are independent claims. Support for the amendments to claims 1, 2, 11, 22, 32, and 33, may be found, for example, on pages

## ***WITHDRAWAL OF NON-FINAL OFFICE ACTION***

Applicant acknowledges the Examiner's withdrawal of the non-final Office Action dated December 8, 2003.

## ***CLAIM AMENDMENTS***

Applicant has amended claims 1, 2, 11, and 22 and the specification by way of this response. Applicant notes that the present application is a National Phase application of a PCT application, which was originally filed in German and translated into English. Accordingly, Applicant asserts that the amendments made to claims 1, 2, 11, and 22 have been made to improve this translation.

As such, Applicant asserts that no new matter has been added to the specification and that the amendments made to claims 1, 2, 11, and 22.

### **CLAIM REJECTIONS UNDER 35 U.S.C. §112**

Claims 32 and 33 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Examiner submits that claims 32 and 33 include "no specific limitations to a device for placing flip chips, while claims 11 and 12 devices are incapable of mounting chips" (see page 2 of the outstanding Office Action). The Examiner further submits that claims 32 and 33 are "ambiguous".

Applicant has amended claims 32 and 33 taking into account the suggestions/comments made by the Examiner in the outstanding Office Action. Further, Applicant submits that all such amendments to claims 32 and 33 have not been made to overcome any prior art rejection and have been made for no other reason than to put claims 32 and 33 in accordance with 35 U.S.C. §112, second paragraph. Accordingly, Applicant respectfully submits that claims 32 and 33 are in accordance with 35 U.S.C. §112, second paragraph and, as such, respectfully requests withdrawal of the above rejection.

### **RESPONSE TO EXAMINERS LACK OF RESPONSE TO RESTRICTION REQUIREMENT**

In response to the Examiner's restriction requirement issued August 18, 2004, Applicant submitted a Response including arguments traversing the Examiner's Restriction Requirement and, new linking claims 32 and 33.

However, the Examiner has failed to acknowledge or respond to Applicant's Response to the Restriction Requirement in the outstanding Office Action.

Instead of responding to Applicant's Response, the Examiner has apparently rejected claims 32 and 33 under 35 U.S.C. §112, second paragraph, while indicating in the Office Action Summary that claims 11-31 remain withdrawn from the present application. Although not explicitly indicated by the Examiner, Applicant assumes that linking claims (e.g., amended claims 32 and 33) in accordance with 35 U.S.C. §112, second paragraph, would serve as proper linking claims.

As discussed in Applicant's Response to Restriction Requirement, Under current USPTO procedures, linking claims are to be examined with the specific invention elected. (MPEP §809). When a linking claim is found to be free of the prior art, based on the initial examination, even though it may be objected to or rejected on formal grounds, the restriction requirement should be withdrawn with respect to any claims that fall within the scope of the linking claim. (*Id.*) In addition, the Examiner must examine the claims to the non-elected inventions that are linked to the elected invention by the allowed linking claim (MPEP §809.04). Therefore, any claim directed to a non-elected invention, previously withdrawn from consideration, which depends from or includes all the limitations of the linking claim that is free of the prior art may be rejoined and can be fully examined for patentability.

According to MPEP §809.04, the Examiner must examine the claims to the non-elected invention that are linked to the elected invention if the linking claims are allowed.

As Applicant believes that amended claims 32 and 33 are in accordance with 35 U.S.C. §112, second paragraph, Applicant respectfully requests that the Examiner acknowledge that claims 32 and 33 are proper linking claims, and examine the claims directed to the non-elected invention that that are linked to the elected invention if the linking claims are allowed.

Further, the Examiner failed to respond to Applicant's argument of no undue burden with respect to search and examination of the entire application. Accordingly, Applicant still respectfully submits that the Examiner would not be unduly burdened if forced to examine Groups I and II (as outlined in the Examiner's restriction requirement issued August 18, 2004) together.

### ***PRIOR ART REJECTIONS***

#### ***Rejections under 35 U.S.C. §102***

Claims 1-10 and 32-33 stand rejected to under 35 U.S.C. §102(b) as allegedly being anticipated by Onitsuka (U.S. Patent No. 5,501,005). Applicant respectfully traverses this rejection, especially in view of claim 1 as now amended.

On page 2 of the outstanding Office Action, the Examiner cites FIGs. 1 and 2 of Onitsuka for allegedly teaching the limitations set forth in claim 1.

However, Applicant respectfully disagrees with the Examiner's conclusion, especially in view of claim 1 as now amended.

FIGs. 1 and 2 of Onitsuka disclose an apparatus for mounting electronic components including a transfer means 51. The transfer means 51 includes arms 52, which further include transfer nozzles 54 provided at the end of each arm 52. As shown in FIG. 2, the transfer means 52, and in turn the transfer nozzles 54, are fixed to a shaft 53a, and rotate intermittently by an angle of 90° together with the shaft 53a. When a locus of a takeout nozzle 13 and a locus of the transfer nozzle 54 intersect, an electronic component is transferred from the takeout nozzle 13 to the transfer nozzle 54. The transferred electronic component 7 is then rotated 180° from the intersection point to a position above a mounting point. The transferred electronic component 7 is then transferred to the mounting point.

However, Applicant respectfully submits that Onitsuka fails to teach or suggest a device adapted to at least pick-up flip chips, and "after flipping the chip," return the "flipped chip", as now set forth in claim 1. As discussed above, while the electronic component 7 is arguably picked up by the transfer nozzle 54, the device (as illustrated in FIG. 1 and 2) does not perform any "flipping" nor return any "flipped chip", as now set forth in claim 1. Instead, the electronic component 7 is merely rotated 180° around a vertical axis (i.e., the shaft 53a) from a pick-up position (i.e., the intersection point between locus of a takeout nozzle 13 and a locus of the transfer nozzle 54), and placed on a substrate. Accordingly, since Onitsuka does not disclose any "flipping" nor a

returning of a "flipped" chip, Onitsuka cannot disclosed the "flipping device", as set forth in claim 1.

Accordingly, Applicant respectfully submits that Onitsuka fails to teach or suggest all the limitations as now set forth in claim 1, and as such respectfully request that this rejection be withdrawn.

Further, with regard to independent claim 11, Applicant respectfully submits that claim 11 is also allowable for at least reasons somewhat similar to claim 1. With regard to dependent claims 2-10 and 12-33, Applicant respectfully submits that these dependent claims are also allowable for at least the reasons set forth above with regard to claims 1 and 11. As such, Applicant respectfully requests withdrawal of all of the above rejections.

### **CONCLUSION**

In view of the above stated reasons, reconsideration and withdrawal of the outstanding restriction/election requirement and favorable allowance of all claims in the instant application are earnestly solicited.

In view of above remarks, reconsideration and withdrawal of the outstanding rejection and allowance of all pending claims is respectfully requested.

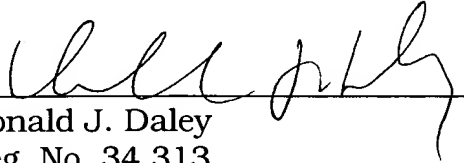
If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Andrew M. Waxman, Reg. No. 56,007, at the number of the undersigned listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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